

5,905,865 to Palmer et al.; 5,237,157 to Kaplan (References A and C, respectively, in the May 4, 2001 Office Action); and 5,710,884 to Dedrick (Reference C in the December 13, 1999 Office Action) were cited. Contrary to the indication in the Office Action Summary, claim 1 is not pending, nor was it rejected or indicated as allowable in the Detailed Action since it was canceled when the application was filed. Thus, since claims 98-104 have been added, claims 2-104 remain in the case. The Examiner's rejections are traversed below.

### **Newly Cited Prior Art**

#### U.S. Patent 5,237,157 to Kaplan

The Kaplan '157 patent is the parent application of the previously cited Kaplan '916 patent. Only the first embodiment disclosed in Kaplan '916 was disclosed in Kaplan '157. As discussed in the previous Amendments, this embodiment disclosed by both Kaplan '157 and Kaplan '916 is a system located in a retail store which permits customers to preview audio programs on compact discs prior to purchase using a kiosk containing a computer executing software that identifies the user each time the kiosk is used and stores information about the recordings that are previewed and purchased by the user.

#### U.S. Patent 5,905,865 to Palmer et al.

The Palmer et al. patent is directed to an apparatus and method for automatically accessing on-line services in response to broadcast of on-line addresses. The system disclosed by Palmer et al. is similar to what is currently available from Web TV, except that use of the vertical blanking interval of a television broadcast is only briefly mentioned at column 8, lines 13-14, while the preferred embodiment uses a paging system to distribute URLs. There is also a description of tracking hits at a web site and storing profiles of users to filter out unwanted URLs. The description at column 8, lines 5-13 of alternatives to the preferred embodiment is so brief that it is not entirely clear what is included, but there may be a suggestion that the URLs can be embedded on a laser disc or compact disc.

### **Rejection of Claims under 35 U.S. C. § 102(b)**

In item two on page 2 of the Office Action, claims 2, 3, 22, 40, 41, 43, 62, 71, 76, 77, 81, 82 and 93-97 were rejected under 35 U.S.C. § 102(b) as anticipated by Fischer using the same language as in the October 20, 2000 Office Action. In item 7 on pages 5-6 of the Office Action, the Examiner stated that the arguments in the Amendment filed March 20, 2001 were not persuasive because in the system taught by Fischer the "identifying codes are embedded and stored ... [as] part of contents of the recording" and "the identifying codes are also played ... to

[the] user during ... playback of the recording." Assuming that the word in parenthesis on the next to last line on page 5 of the Office Action was intended to be "invisibly," the Examiner has recognized that Fisher displays data "in a minor area of the TV picture " (Fischer Abstract, line 5) that is a "visually insignificant area of a picture" (column 6, line 19). Although neither of these quotations are from the Specific Description section of Fisher the fact that the latter quotation is from claim 1 emphasizes the importance to the system taught by Fischer of displaying the identifying information as unnoticeably as possible.

The independent claims have been amended in a variety of ways to clarify what was meant by the phrase "used for playback to the user" which was added to all of the independent claims in the March 20, 2001 Amendment. Claim 2 has been amended to recite that the recording is "identified by information obtained from the recording used to play back contents of the recording **perceived** by the user and not stored to identify the recording" (claim 2, lines 5-7). As emphasized by the use of bold text in the preceding quote, the present invention differs from what is taught (and claimed) by Fischer in that the recording is identified by the "contents of the recording perceived by the user" rather than some additional information that is added either at the time of broadcast or at the time that the broadcast is recorded by the user and is subsequently displayed as inconspicuously as possible. Claims 22, 41 and 62 recite identifying the recording based on "information obtained from contents of the recording stored in the medium for a purpose other than identifying the recording" (e.g., claim 22, lines 5-6). This is the exact opposite of what is taught by Fischer which is identifying the recording from information specifically added, either by the broadcaster or the device making the recording, to identify the recording. For the reasons set forth above, it is submitted that claims 2, 22, 41 and 62 patentably distinguish over Fischer.

Claims 43, 93 and 95-97, using language similar to that in claim 2, require that the information used to identify the recording is "obtained from contents of the recording used to play back contents of the recording perceived by a user" (e.g., claim 93, lines 4-5). Therefore, it is submitted that claims 43, 93 and 95-97 patentably distinguish over Fischer for the reasons discussed above with respect to claim 2.

Claim 94 includes limitations similar to the final phrase in the identifying step recited in claim 2 and adds details regarding a recording that has at least one segment. Specifically, claim 94 recites that the information used to identify a segment of a recording is "obtained from or related to the segment and included in the recording to enable playback of the segment rather than to identify the segment" (claim 94, lines 4-6). First, it is unclear what would correspond to a

"segment" in the system disclosed by Fischer and second, the information used for identification in the system taught by Fischer, as noted above, is specifically added for the purpose of identifying the recording. Therefore, it is submitted that claim 94 patentably distinguishes over Fischer.

Claims 3, 40, 43, 71, 76, 77, 81 and 82 depend from claims 2, 22, 41 and 62 and therefore, patentably distinguish over Fischer for the reasons discussed above with respect to the independent claims from which they depend.

### **Rejection of Claims under 35 U.S.C. § 103**

In item 3 on page 3 of the Office Action, claims 4, 16, 17, 44, 45, 54, 55, 72, 74, 78, 80 and 83-92 were rejected under 35 U.S.C. § 103 as unpatentable over Fischer in view of Kaplan '157. As discussed above, Kaplan '157 is limited to a kiosk system in which the audio data listened to by a user is known to the system, because it is supplying the audio signal, and only the user must be identified. As a result, there is little discussion of how the audio is identified by system disclosed in Kaplan '157 and no suggestion has been found in Kaplan '157 of modifying the system taught by Fischer to use the content of the recording perceived by the user as recited in the claims, rather than separate identifying information as taught by Fischer. Therefore, it is submitted that claims 4, 16, 17, 44, 45, 54, 55, 72, 74, 78, 80 and 83-92 which depend from claims 2, 22, 41, 43 and 62 patentably distinguish over Fischer for the reasons discussed above in the preceding section.

In item 4 on pages 3-4 of the Office Action, claims 5, 6, 18, 19, 27, 28, 31, 32, 35-38, 46, 47, 56, 57, 63 and 65-70 were rejected under 35 U.S.C. § 103 as unpatentable over Fischer in view of Kaplan '157 and Palmer et al. Nothing was found in Palmer et al. regarding identification of recordings played "at a first device connectable to a second device via a network" (e.g., claim 2, line 2). Rather, as discussed above, Palmer et al. describes ways of providing URLs to a computer in synchronism with audio or video content. When the audio/video content is being played from a recording, the URLs are apparently embedded in the recording, while in the primary embodiment, the URLs are transmitted to the computer in synchronism with broadcast audio/video signals. Thus, it is submitted that Palmer et al. contains no suggestion of modifying Fischer to meet the limitations recited in the independent claims and discussed above as distinguishing over Fischer. Since claims 5, 6, 18, 19, 27, 28, 31, 32, 35-38, 46, 47, 56, 57, 63 and 65-70 depend from claims 2, 22, 43, and 62, it is submitted that these dependent claims patentably distinguish over Fischer in view of Kaplan '157 and Palmer et al. for the reasons set forth above with respect to the rejection of the independent claims under 35 U.S.C. § 102(b).

In item 5 on page 4 of the Office Action, claims 7-15, 20, 21, 23-26, 39, 42, 48-53 and 58-61 were rejected under 35 U.S.C. § 103 as unpatentable over Fischer in view of Palmer et al. and Dedrick. As discussed in the March 20, 2001 Amendment, it is submitted that Dedrick contains no suggestion of modifying Fischer to identify recordings based on anything other than information added for that purpose. Since claims 7-15, 20, 21, 23-26, 39, 42, 48-53 and 58-61 depend from claims 2, 22, 41 and 43, it is submitted that these dependent claims patentably distinguish over Fischer in view of Palmer et al. and Dedrick for the reasons discussed above with respect to how these independent claims distinguish over Fischer taken alone.

### **New Claims**

Claims 98-104 have been added to further emphasize ways in which the present invention distinguishes over the cited prior art. Claim 98 recites that each segment of the medium is a portion of a track on a compact disc "determined by track number and playing time within the track" (claim 98, lines 2-3). No mention has been found in any of the cited references regarding how compact discs could be identified, let alone specific portions of a track. Therefore, it is submitted that claim 98 further patentably distinguishes over the prior art.

Claim 99 recites that "the information used to identify the recording is stored in the medium prior to possession of the medium by the user." This clearly is not taught by Fischer which has two embodiments both relying upon a recording made by a user's VCR and Kaplan '157 ends with the user receiving possession of the recording and contains no suggestion of how subsequent playback of the recording could be identified. The system taught by Palmer et al. might suggest that URLs could be embedded in a compact disc, but does not suggest how a compact disc could be identified using content not specifically stored for that purpose. Since Dedrick similarly lacks any suggestion relevant to identifying a recording in the possession of a user from information stored with the recording prior to receipt of the recording by the user, it is submitted that claim 99 further patentably distinguishes over the prior art due to the additional detail recited therein.

Claims 100-104 recite that "the information used to identify the recording was not stored for the purpose of identifying the recording" which is similar to the limitations recited in claims 2, 22 and 41, and respectively depend from the other independent claims to add this distinguishing limitation.

## Request for Examiner Interview

If all of the claims are not allowed as a result of this Amendment, the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Examiner Interview to discuss whether any of the new language results in additional claims being allowable. This will expedite the process of amending any claims that continue to be rejected.

## Summary

It is submitted that the references cited by the Examiner, taken individually or in combination, do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 2-104 are in a condition suitable for allowance. Entry of this Amendment, reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

If any further fees are required in connection with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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### CERTIFICATE UNDER 37 CFR 1.8(a)

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